

REMARKS

The Examiner has combined Van Keppel et al., with DiMatteo and/or Lawrence and/or Hover and/or Hedge, but Van Keppel et al. expressly teaches away from any combination that would make the mechanism of Van Keppel et al. “more complex and costly,” as disclosed in column 1, ll. 22-26. Thus, no person having ordinary skill in the art would combine the mechanisms of the other cited references with Van Keppel et al., because the mechanisms of the other references are more complex and costly and Van Keppel et al. expressly teaches away from such a change.

The Office Action admits that Van Keppel et al., fails to teach or suggest “a pair of blades, each of the pair of blades having a pivot axis, a plurality of gear teeth securely fixed on the blade and extending radially outwardly from the pivot axis ...,” as recited in claim 12. Also, the Office Action admits that Van Keppel et al. fails to teach or suggest “... the pair of connecting elements are spaced apart such that the plurality of gear teeth of one of the pair of blades, operatively meshes with the plurality of gear teeth of the other of the pair of blades...,” as recited in claim 12, also.

Indeed, a fair reading of Van Keppel et al. suggests that the mechanism disclosed by Van Keppel et al. is more than adequate, because the scissor-like action of the hinged blades provides a better mechanical advantage than the prior art devices. Thus, there is no reason to modify Van Keppel et al. in the way suggested in the Office Action, especially when Van Keppel et al. expressly teaches away from the need for any more complex and costly mechanism. Van Keppel et al. expressly teaches away from any combination that would make the mechanism of Van Keppel et al. “more complex and costly,” as disclosed in column 1, ll. 22-26. Thus, no person having ordinary skill in the art would combine the mechanisms of the other cited references with Van Keppel et al., because the mechanisms of the other references are more complex and costly and Van Keppel et al. expressly teaches away from such a change.

The U.S. Supreme Court recognized, in its decision in *KSR v. Teleflex*, that such an express teaching away in a reference is strong evidence of nonobviousness that must be given great weight in any determination of nonobviousness. The Office Action fails to address Applicant’s reasonable reliance on the teachings of Van Keppel et al., the Office Action’s primary reference, merely stating that Applicant’s arguments are “moot in view of the new ground(s)” of rejection. However, the new ground(s) for rejection still use Van Keppel et al. as the primary reference. Failure to consider this

evidence of teaching away is improper and appropriate weight must be given to the fact that Van Keppel et al. expressly teaches away from any “more complex and costly” mechanism.

Since none of the other references and nothing in the general knowledge of a person having ordinary skill in the art of cigar cutters would overcome the express teachings of Van Keppel et al., the Applicant traverses the combination of the other references, which can only be described as general background references unrelated to the art of cigar cutters, and Van Keppel et al.

In a recent case, *In re Kubin*, Case No. 2008-1184 (Fed. Cir. 2009), the United States Court of Appeals for the Federal Circuit clarified the application of “obvious to try” and hindsight reasoning as it relates to the determination of obviousness or nonobviousness. Specifically, *Kubin* is a response to the decision in *KSR*, which clarifies when “obvious to try” is erroneously equated with obviousness under Section 103. In the present case, the general references to larger, heavier and complicated shears and the like are assuredly the types of mechanisms that the primary reference teaches away from, and there are many types of mechanisms that are known and used in cigar cutters. However, the Office Action found it necessary to go outside of the field of cigar cutters to find references to support a rejection for obviousness in combination with a reference that teaches away from more complex and costly mechanisms. Furthermore, nothing in the prior art shows that there is any “design need or market pressure to solve” a problem in the cutting of cigars. Instead, there a plethora of solutions for cutting a cigar and the Van Keppel et al. reference teaches one way while teaching away from “more complex and costly” mechanisms. There is no limit to the ingenuity and variety of solutions that might be considered by a person having ordinary skill in the art in order to perfect a cigar cutting tool. Many have already been invented and patented. When the prior art gives either no indication of which parameters are critical or provides no direction as to which of many possible choices that is likely to be successful, and there a numerous possible choices to try, then the office should “not succumb to hindsight claims of obviousness.” Under the present circumstances, the reference cited as the primary reference actually teaches away from the type of combination contemplated by the Office Action. Thus, it is not even “obvious to try” the combination suggested in the Office Action. Instead, any indication or direction provided by the cited references warns a person having ordinary skill in the art away from the combination put forward by the Office Action, and the only reason for proceeding with the combination suggested is impermissible hindsight reasoning based on the Applicant’s own disclosure and claims. The

Applicant's invention is not a mere combination of a "finite number of identified, predictable solutions" from "known options" and is not in "a promising field of experimentation" where the improvement is merely a "predictable use of prior art elements according to their established functions" in the field of experimentation. Instead, Applicant's invention is a nonobvious combination over the primary prior art reference using a mechanism not considered for use in the field previously and in a nonobvious way that improves the mechanism with surprisingly little additional complexity or cost. By ignoring the warnings in the prior art and going against conventional wisdom, the Applicant's claims are nonobvious over the cited prior art.

The Applicant asserts that the only reason to make the combinations suggested in the Office Action is by using impermissible hindsight reasoning under the precedent established by the U.S. Supreme Court and the U.S. Court of Appeals for the Federal Circuit. Based on the Applicant's disclosure of the unexpected advantages recited in the Applicant's specification, and the teaching away of the most closely related (and primary) reference cited against the claims, the Applicant respectfully requests consideration of the above remarks, reconsideration of the rejections, and allowance of all of the pending claims.

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Respectfully submitted,



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